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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHELL S. SIMPSON and WARD S. FOSTER

Appeal 2009-000932
Application 09/874,106¹
Technology Center 2400

Decided: September 14, 2009

*Before JEAN R. HOMERE, JAY P. LUCAS, and THU A. DANG,
Administrative Patent Judges.*

LUCAS, Administrative Patent Judge.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal from a twice rejection of claims 1-16 and 18-36 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and

¹ Application filed June 4, 2001. The real party in interest is Hewlett-Packard Development Company, LP.

Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). Claim 17 was cancelled.

Appellants' invention relates to a system and method of converting image files stored and accessed via the Internet. (*See* Spec. 9, ll. 1-4.) A problem in the art of electronically transferring digital files at the time Appellants' claimed invention was made was that special software had to be installed on an end user's computer before print jobs could be sent. (*See* Spec. 3, ll. 13-15.) Once sent, the destination printer also required special firmware to receive and properly output the print job (*id.* at ll. 15-17). However, pre-configuration schemes for sending and receiving image files were wasteful, burdensome, and inflexible (*id.* at ll. 17-20). Accordingly, in the words of Appellants:

The present invention is directed to an improved system and method for servicing imaging data stored in a personal imaging repository. More particularly, the present invention relates to a system and method for servicing imaging data stored in a personal imaging repository by a requested web service operably connected to a computing device requesting the service.

(Spec. 3, ll. 22-26).

Once the imaging data is stored in the personal imaging repository, it can be freely used by other web services or the user at a later time. Furthermore, it is no longer necessary for the imaging data to be downloaded to the requested web service, since services are configured to directly access the personal imaging repository.

(Spec. 9, ll. 7-11).

Claim 1 is exemplary:

1. A system for servicing imaging data comprising digital data capable of being represented as two dimensional graphics stored in a personal imaging repository by a requested web service operatively connected to a computing device requesting the service, comprising:

a computing device for requesting service with the requested web service;

a personal imaging repository associated with a particular user profile for storing imaging data that is to be accessed by the requested web service, wherein said personal imaging repository is an exchange infrastructure between the imaging data and available web services;

user information for allowing access to said personal imaging repository;

a requested web service for servicing the imaging data stored in said personal imaging repository responsive to a request from a user and upon having access to said personal imaging repository granted upon receiving said user profile, wherein said requested web service has access to add data to said imaging data stored in said personal imaging repository once said imaging data is serviced for a first time, said imaging data being made available to being freely used by other web services.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Morris	US 6,353,848 B1	Mar. 05, 2002 (filed on Jul. 31, 1998)
Anderson	US 6,499,016 B1	Dec. 24, 2002 (filed on Feb. 28, 2000)
Wood	US 6,732,162 B1	May 04, 2004 (filed on Nov. 15, 1999)

Tate US 7,069,237 B1 Jun. 27, 2006
(filed on Nov. 10, 2000)

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 1-7, 10-16, 18-25, 27, 32, 35, and 36 stand rejected under 35 U.S.C. § 103(a) for being obvious over Anderson in view of Tate.

R2: Claims 8, 9, 26, 29-31, and 34 stand rejected under 35 U.S.C. § 103(a) for being obvious over Anderson in view of Tate and further in view of Wood.

R3: Claims 28 and 33 stand rejected under 35 U.S.C. § 103(a) for being obvious over Anderson in view of Tate and further in view of Morris.

The first claim in each of the three rejections is representative, unless otherwise noted. See 37 C.F.R. § 41.37(c)(vii).

Appellants contend that the claimed subject matter is not rendered obvious by Anderson and Tate because the claim limitations “said requested web service has access to add data to said imaging data stored in said personal imaging repository” and “said imaging data being made available to being [sic] freely used by other web services” are not disclosed. (*See* Brief 10, bottom to 11, top.) The Examiner contends that each of the claims is properly rejected (Ans. 14, top).

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Brief and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this

opinion. Arguments that Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived.

We affirm the rejections.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether Tate discloses Appellants' claim limitations "said requested web service has access to add data to said imaging data stored in said personal imaging repository" and "said imaging data being made available to being [sic] freely used by other web services," as recited in exemplary claim 1.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a system, method, and program product for servicing imaging data stored in a personal repository and accessible to other entities called "web resources." (*See* claims 1, 19, and 36; Spec. 3, ll. 22-26.) No definitions of the claim limitations "being freely used," "requested web resources," or "other web resources" are given in Appellants' glossary of terms. (*See* Spec. 9, l. 26 to 10, l. 5.)
2. The Anderson reference discloses storing image files in a database that is accessible via a network. (*See* Abstract.)
3. The Tate reference discloses storing a customer's images at a retailer's server and adding hotlinks so that the customer can access the images.

(*See* col. 5, ll. 24-29; Ans. 12, middle to bottom.) The images in Tate are available for access by other parties who may make improvements or additions to the images. (*See* col. 6, ll. 9-14; Ans. 13, bottom.)

4. The Wood reference discloses a converter for converting multiple types of image files, such as JPEGs (Joint Photographic Experts Group, or digital picture files). (*See* col. 9, ll. 5-7 and 9-14; Ans. 9, bottom.)
5. The Morris reference discloses a method for accessing a digital image capture unit via a network. (*See* Abstract.) Morris further discloses inserting an Internet address inside a data request and sending the data request to a web server (col. 13, ll. 33-35).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow."

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a *prima facie* case for the rejections of Appellants' claims under 35 U.S.C. § 103(a) on pages 3 to 11 of the Examiner's Answer. In opposition, Appellants present a number of arguments.

*Arguments with respect to the rejection
of claims 1 to 7, 10 to 16, 18 to 25, 27, 32, 35, and 36
under 35 U.S.C. § 103(a) [RI]*

The first argument addresses whether Tate discloses Appellants' claim limitation "said requested web service has access to add data to said imaging data stored in said personal imaging repository," as recited in exemplary claim 1. (*See* Brief 11, bottom.) More specifically, Appellants argue:

Tate does not disclose that a first web service is used to add images to a second web service, since a customer or other parties interact directly with the server holding the digital images. As such, Tate fails to teach or suggest [the claim limitations mentioned above]. For example, at most, Tate discloses that data may be downloaded from or transferred away from a server but not that data may be added to the server from other web services.

(Brief 12, middle to bottom).

In reply, the Examiner finds that Tate discloses a customer connected, via the Internet, to a retailer that stores (on its server) the customer's digital images for image processing purposes. (*See* Tate col. 3, l. 50 to col. 4, l. 4; col. 5, ll. 24-29 and 34-49; Ans. 13, middle.) The Examiner finds that the customer can instruct the retailer to modify the customer's stored images for additional processing while allowing other individuals to improve and add to the images stored by the retailer's server. (*See* Tate col. 4, ll. 5-19 and 38-53; col. 9, ll. 9-14; col. 7, ll. 7-37; col. 7, ll. 49-53; Ans. 13, bottom.)

We begin our analysis by noting that Appellants' argument that "a first web service is used to add images to a second web service" is not commensurate with the scope of the claim limitation "said requested web service has access to add data." Merely reciting "has access to add data to

said imaging data,” as claimed, is broader in scope than actually adding images as argued above. (*See* Brief 12, middle to bottom.) Thus, Tate’s disclosure that retailers could have possibly added data to a customer’s stored images is sufficient to meet the claim limitation. Since the mere possibility of adding imaging data meets the broad claim limitation “access to add images,” we find unpersuasive Appellants’ argument regarding a first web service “used to add images to a second web service.”

Appellants then argue that “said imaging data being made available to being freely used by other web services” as recited in claim 1 is not disclosed in Tate (Brief 11, top to middle).

The Examiner points out in the Answer that Tate discloses storing the customer’s images at the retailer’s server and adding hotlinks so that the customer can access the images (FF#3). In addition, the Examiner finds that the images would have been available for access by other parties (*id.*).

The Examiner has interpreted “said imaging data being made available to being freely used by other web services” as reading on Tate’s disclosure of making imaging data available to third parties via hotlinks. (*See* FF#3.) Reading the claims broadly but reasonably (*see In re Zletz*, 893 F.2d at 321), we construe “being freely used” as reading on Tate’s disclosure of providing hotlinks that make images accessible not only to the customer but also to other parties or entities (FF#3). Furthermore, we construe Appellants’ claimed “other web services” as reading on Tate’s disclosure of the access mechanism allowing third parties to access the imaging data (*id.*). In light of our reading of the claim language and since no definitions of Appellant’s claimed “being freely used” or “other web services” are given in the Specification (FF#1), we find unconvincing Appellants’ narrow reading

of the claim language. Accordingly, we decline to find error with the Examiner's analysis.

Next, Appellants argue that "Tate discloses that data may be downloaded from or transferred away from a server but not that data may be added to the server from other web services." (Brief 12, middle to bottom; Board's emphasis).

The Examiner finds that a retailer or third party would have had access to tweak or improve the images stored in the dynamic access area. (See FF#3.) We note that Appellants have again chosen not to define a claim limitation, namely the claimed "requested web service," in the Specification (FF#1). Instead, Appellants' disclosure provides non-limiting examples ("the range of services that the web services can offer are limitless" (Spec. 10, ll. 1-2)) of web services (e.g., printing, copying, emailing, and scanning services) (FF#1). We find that Tate's teachings for third-party entities with access to improve or adjust a customer's images are the same as Appellants' claimed "[having] access to add data" since improving or adjusting image files effectively adds data to those files in a manner not inconsistent with the Specification. We thus decline to find error in the Examiner's analysis.

*Arguments with respect to the rejection
of claims 8, 9, 26, 29 to 31, and 34
under 35 U.S.C. § 103(a) [R2]*

Dependent claim 8 recites, in relevant part, "said personal imaging repository further comprising a converter for converting the imaging data to any of said plurality of file formats." Dependent claim 9 recites, in part, a

“plurality of file formats of said personal imaging repository is any one from the group consisting of: Joint Photographic Experts Group Format.”

Regarding claims 8 and 9, Appellants argue that Wood does not disclose “said requested web service has access to add data to said imaging data stored in said personal imaging repository.” (*See Brief 21, top.*)

We have closely reviewed Appellants’ arguments, the Examiner’s cited portion of Wood, and, indeed, the entire reference. We find that the Examiner cited Wood for disclosing a converter device for converting a plurality of image file formats. (*See FF#4.*) Since the Examiner actually cited Tate (and not Wood) for disclosing “said requested web service has access to add data to said imaging data stored in said personal imaging repository” (*see FF#3*) and Wood for merely disclosing a converter device that converts multiple types of image files (*see FF#4*), we find unconvincing Appellants’ argument that Wood’s failure to disclose the argued limitation is reversible error on the Examiner’s part. We thus decline to find error in the Examiner’s rejection of claims 8 and 9.

Regarding claims 26, 29-31, and 34, Appellants have made no additional arguments distinguishing the claims over the prior art. (*See Brief 21, bottom.*) Thus, we decline to find error in the Examiner’s analysis.

*Arguments with respect to the rejection
of claims 28 and 33
under 35 U.S.C. § 103(a) [R3]*

Appellants have made no arguments distinguishing the claims over the Morris reference. (*See Brief 22, top to 23, top.*) A general allegation (e.g., “Morris fails to cure the deficiencies of the Anderson and Tate

references" (*see* Brief 23, middle)) that the claim defines a patentable invention without specifically pointing out how the language of the claims patently distinguishes them from the references does not constitute a persuasive response (37 C.F.R. § 1.111(b).)

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1-7, 10-16, 18-25, 27, 32, 35, and 36; claims 8, 9, 26, 29-31, and 34; and claims 28 and 33 under [R1], [R2], and [R3], respectively.

DECISION

The Examiner's rejections ([R1], [R2], and [R3]) of claims 1-16 and 18-36 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

peb

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